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EXAMINER

WON, MICHAEL YOUNG

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/918,279	Applicant(s) KAYE, EVAN JOHN	
	Examiner Michael Y. Won	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 14-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12 and 14-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendments filed October 19, 2005 and June 15, 2006.
2. Claims 1, 3, 8-10, and 16 have been amended and claims 2 and 13 have been cancelled.
3. New claims 22 and 23 have been added.
4. Claims 1, 3-12, and 14-23 have been examined and are pending with this action.

Response to Amendment

5. The declarations filed on June 15, 2006 under 37 CFR 1.131 are sufficient to overcome the Lee et al. (US 6,611,814 B1) reference.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 10-12, 14-19, 22, and 23 have been rejected under 35 U.S.C. 102(e) as being anticipated by Franklin et al. (US 6,125,352 A).

INDEPENDENT:

As per **claim 1**, Franklin teaches a method for facilitating purchases of gift items that are made available for purchase from a host server, comprising the steps of:

a) downloading a component (see col.1, lines 15-18 & 53-58) to a client machine (see col.2, lines 56-58: "*sending a first hypertext document over the distributed network to a user computer*");

b) a user providing a permission for the downloaded component to access an address book maintained on the client machine (see col.9, lines 42-46: "*The consumer then authorizes access to the payment source and address information stored on the consumer computer by entering a password*" and col.10, lines 44-48: "*permits the*

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commerce client 122 and the commerce server 130 to pass function calls to each other");

c) retrieving at least a set of names of potential gift recipients from an address book (see Fig.5, #514 & #516; col.9, line 63-col.10, line 1: *"address book in which shipping addresses can be recorded"*; and col.18, lines 49-67: *"address book object 514 accesses and manipulates address book data structures"*);

d) using the component, combining into a selection form at the client machine one or more gift items available through the host server and the set of names of the potential gift recipients (see col.16, line 38-col.17, line 25: TABLE 2);

e) enabling the user at the client machine to associate from within the selection form the one or more gift items with particular names in the set of names to thereby define a set of intended gift recipients (see col.4, lines 50-57: *"permits a user to purchase products from an on-line merchant... select a shipping address and also to place an order to the merchant for the selected product"* and col.14, lines 38-48); and

f) forwarding to the host server a portion of the address book contents (implicit) which concerns the particular names in the set of names that have been associated with the gift items (see col.4, lines 57-61: *"A network connection is established for the commerce client to communicate the order to the commerce server"*).

As per **claim 18**, Franklin teaches a method for facilitating purchases of gift items made available for purchase by a host server, comprising the steps of:

a) downloading to a client machine a component (see col.1, lines 15-18 & 53-58) from the host server, the component including a selection template which coordinates with information in an address book (see col.16, line 38-col.17, line 25: TABLE 2) which is accessible from the client machine (see col.2, lines 56-58: *"sending a first hypertext document over the distributed network to a user computer"*);

b) retrieving into the component at least a set of names of potential gift recipients from the address book (see Fig.5, #514 & #516; col.9, line 63-col.10, line 1: *"address book in which shipping addresses can be recorded"*; and col.18, lines 49-67: *"address book object 514 accesses and manipulates address book data structures"*);

c) retrieving from the host server a set of gift items, each of which is associable with one or more names in the set of potential gift recipients (see col.2, line 54-col.3, line 22);

d) displaying in a browser operating at the client machine a matrix of selection cells which is defined by intersecting rows and columns, one of the rows and columns denoting the set of gift items and the other denoting the names in the set of potential gift recipients (see col.16, line 38-col.17, line 25: TABLE 2); and

e) enabling the user to associate names in the set of potential gift recipients with gifts in the set of gift items by interacting with one or more selection cells to thereby define a set of intended gift recipients (see col.4, lines 50-57: *"permits a user to purchase products from an on-line merchant... select a shipping address and also to place an order to the merchant for the selected product"* and col.14, lines 38-48).

As per **claim 23**, Franklin teaches a method for facilitating purchases of gift items that are made available for purchase from a host server, comprising the steps of:

using a browser executing at a client machine (see col.2, lines 35-41: *"in conjunction with a standard Web browser"* and col.7, lines 45-48), adding the gift items available for purchase from the host server to an electronic shopping basket (see col.8, lines 64-66: *"Add Items to Shopping Basket"*); and

in connection with a checkout by a user at the client machine:

a) prompting the user with a permission request to access (see col.9, lines 42-46: *"The consumer then authorizes access to the payment source and address information stored on the consumer computer by entering a password"*; col.10, lines 41-48; and col.12, lines 24-48) a particular address book including at least a set of names (see col.9, line 63-col.10, line 1: *"an address book in which shipping address can be recorded"*);

b) testing for the presence of a component on the client machine (implicit: see col.16, lines 25-27); and

c) in the event that the component is present on the client machine (implicit: see col.7, lines 45-48: *"and a specialized commerce client process 122 execute on the processing unit"*):

1) retrieving at least the set of names from the particular address book using the component (see col.16, lines 25-29: *"it performs an initial task of loading structures in memory from data stored... The data represent... shipping addresses"*);

2) constructing a selection form which presents a matrix of selection cells, wherein each selection cell is at the intersection of a particular one of the added gift items from the electronic shopping basket and a particular name from the retrieved set of names (see col.16, line 38-col.17, line 25: TABLE 2);

3) displaying in the browser the constructed selection form (see col.16, line 38-col.17, line 25: TABLE 2);

4) enabling the user at the client machine to associate from within the selection form at least the particular one of the gift items with at least the particular name to thereby define a set of intended gift recipients (see col.4, lines 50-57: *"permits a user to purchase products from an on-line merchant... select a shipping address and also to place an order to the merchant for the selected product"* and col.14, lines 38-48); and

5) forwarding to the host server the set of intended gift recipients including at least the particular name retrieved from the particular address book (see col.4, lines 57-61: *"A network connection is established for the commerce client to communicate the order to the commerce server"*).

DEPENDENT:

As per **claim 10**, which depends on claim 1, Franklin further teaches of including the additional step, once the set of intended gift recipients has been defined, of presenting at the client machine a shipping form which is automatically populated with

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the names and shipping information for each of the intended gift recipients, the shipping information including an address which is retrieved from the address book (see col.14, lines 38-48 and col.23, lines 7-14).

As per **claim 11**, which depends on claim 10, Franklin further teaches of including the additional step of providing the names and shipping information of the intended gift recipients to the host server (see col.4, lines 57-61: "*A network connection is established for the commerce client to communicate the order to the commerce server*").

As per **claim 12**, which depends on claim 10, Franklin further teaches wherein the shipping information for at least one of the intended gift recipients is populated in the shipping form free of manual entry by the user (implicit: see col.12, lines 25-48).

As per **claim 14**, which depends on claim 1, Franklin further teaches wherein the address book is retrieved from the client machine (see Fig.4).

As per **claim 15**, which depends on claim 1, Franklin further teaches wherein the address book is retrieved from a third party server (see col.4, lines 59-61 and col.15, lines 47-51: "*selectively stored*").

As per **claim 16**, which depends on claim 1, Franklin further teaches of including the additional step of executing the component at the client machine, which performs the retrieving and combining steps (see claim 1 rejection above).

As per **claim 17**, which depends on claim 1, Franklin further teaches wherein the selection form displays, for each name in the set of potential gift recipients, any prior gift item associations that were made in a previous session with the host server (see col.21,

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line 57-col.22, line 7) so as to advise a user of a possible repeat gift item purchase (subjective).

As per **claim 19**, which depends on claim 18, Franklin further teaches of including the additional step of providing the set of intended gift recipients to the host server free of manual entry of the names of the intended gift recipients (implicit: see col.12, lines 25-48).

As per **claim 22**, which depends on claim 1, Franklin further teaches including the additional step of adding the gift items available for purchase from the host server to an electronic shopping basket, wherein steps (b) through (f) are performed after the adding step in connection with a checkout by the user at the client machine (see col.8, lines 64-66: *"Add Items to Shopping Basket"*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3-9, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al. (US 6,125,352 A) in view of Chui et al. (US 6,657,702 B1).

As per **claim 3**, which depends on claim 1, Franklin does not explicitly teach of including the additional step of enabling the user at the client machine to associate a message with a potential gift recipient.

Chui teach of including the additional step of enabling the user at the client machine to associate a message with a potential gift recipient (see col.3, lines 13-15; col.11, lines 30-34; and col.14, lines 52-65).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Chui within the system of Franklin by implementing including the additional step of enabling the user at the client machine to associate a message with a potential gift recipient within the method for facilitating purchases gift items because Franklin teaches that the present invention concerns electronic shopping and is applicable to purchasing products via the Internet (see col.4, lines 15-18) which is clearly known in the art to enable one to purchase gifts for others. Therefore, if a user purchased gifts for others, it would have been obvious to enable users to associate a message with a potential gift recipient because this would allow the recipient to know who and why the gift was sent.

As per **claim 4**, which depends on claim 3, Franklin does not explicitly teach wherein the message is entered by the user.

Chui teaches wherein the message, is entered by the user (see Fig.5, #522; col.11, lines 30-34: "*personal message*"; and col.15, lines 40-45).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Chui within the system of Franklin by

implementing entering messages by a user within the method for facilitating purchases gift items because the user is the person purchasing the product. Therefore if a user purchases a gift for another person in the address book, the user would be entering the message corresponding to the gift as well as all information pertaining to the purchase.

As per **claim 5**, which depends on claim 3, Franklin does not explicitly teach wherein plural messages can be entered by the user, and wherein the user can select any one of the plural messages for associating with a particular recipient in the set of potential gift recipients.

Chui further teaches wherein plural messages can be entered by the user, and wherein the user can select any one of the plural messages for associating with a particular recipient in the set of potential gift recipients (see Fig.5, #522; col.11, lines 30-34: "*personal message*"; and col.15, lines 40-45).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Chui within the system of Franklin by implementing entering plural messages by the user, and wherein the user can select any one of the plural messages for associating with a particular recipient in the set of potential gift recipients within the method for facilitating purchases gift items because the user is the person purchasing the product and Franklin teaches of purchasing plurality of products. Therefore if a user purchases a gift for another person in the address book, the user would be entering the message corresponding to the gift as well as all information pertaining to the purchase so that the recipients would know who and why the gift was sent.

As per **claim 6**, which depends on claim 3, Franklin further teach wherein plural messages are displayed at the client machine, any one of which is associable with a particular recipient in the set of potential gift recipients (see col.29, lines 10-17)

As per **claim 7**, which depends on claim 3, Franklin further teaches wherein the selection form further includes the at least one message which the user is enabled to associate with the potential gift recipient (see col.16, line 38-col.17, line 25: TABLE 2).

As per **claims 8 and 20**, which depend on claims 1 and 18, respectively, Franklin does not explicitly teach wherein the association of gift items with potential gift recipients, is made by selecting a radio button, which is displayed at the client machine.

Chui teaches wherein the association of gift items with potential gift recipients, is made by selecting a radio button, which is displayed at the client machine (see col.16, lines 40-48).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Chui within the system of Franklin by implementing associating gift items with potential gift recipients, is made by selecting a radio button, which is displayed at the client machine within the method for facilitating purchases gift items because Franklin teaches that the system is browser-based (see col.2, lines 35-38) and uses existing components and protocols of the World Wide Web (see col.4, lines 18-20), which is known in the art to employ and display radio buttons and also because employing radio buttons is subjective and subjective limitations do not patentably distinguish the invention.

As per **claims 9 and 21**, which depend on claims 1 and 18, respectively, Franklin does not explicitly teach wherein the association of gift items with potential gift recipients, is made by selecting a checkbox, which is displayed at the client machine.

Chui teaches wherein the association of gift items with potential gift recipients, is made by selecting a checkbox, which is displayed at the client machine (see col.18, lines 20-24).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Chui within the system of Franklin by implementing associating gift items with potential gift recipients, is made by selecting a checkbox, which is displayed at the client machine within the method for facilitating purchases gift items because Franklin teaches that the system is browser-based (see col.2, lines 35-38) and uses existing components and protocols of the World Wide Web (see col.4, lines 18-20), which is known in the art to employ and display checkbox means and also because employing checkbox is subjective and subjective limitations do not patentably distinguish the invention.

Response to Arguments

8. Applicant's arguments with respect to claim 1, 18, 22, and 23 have been considered but are moot in view of the new ground(s) of rejection. After further consideration, previously cited reference Franklin et al. (US 6,125,352 A) in view of Chui et al. (US 6,657,702 B1) has been found to better teaches the claimed invention. For

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the rejections set forth above, claims 1, 3-12, and 14-23 have been rejected and are pending with this action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Won

A handwritten signature in black ink, appearing to read 'Michael Won', with a stylized, flowing script.

July 27, 2006